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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,112	08/15/2001	James E. King	5681-04000	9998

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EXAMINER

MCCARTHY, CHRISTOPHER S

ART UNIT

PAPER NUMBER

2113

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

1 A 1

Office

Office Action Summary

Application No.

09/930,112

Applicant(s)

KING, JAMES E.

Examiner

Christopher S. McCarthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11, 12, 14, 16-27-34 is/are rejected.
- 7) ☒ Claim(s) 7-10, 13, 15 and 35-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7.8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The abstract title misspells the word "Apparatus". Also, line 25 reads "Fig. 9" without apparent relation to anything in the abstract. Appropriate correction is required.

Claim Objections

2. Claim 29 is objected to because of the following informalities: line 25 misspells the word "signaling". Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Current application claims a control program, which embodies an algorithm and is not patentable per se. Applicant is advise to claim a physical embodiment, such as a *control program product on a computer-readable medium*.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 11-12, 14, 16-21, 27-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Craig et al. U.S. Patent 6,260,111.

As per claim 1, Craig teaches a processing unit connectable to a data communications network, the processing unit comprising a device reader operable to read a supplied network identity from a portable storage device, the processing unit being operable to use the supplied network identity from the portable storage device for communicating via the data communications network, the processing unit being operable to monitor a continued presence of the portable storage device, and, in the event of the removal of the portable storage device from the device reader, to signal a fault state (column 4, lines 28-32; column 8, lines 3-9).

As per claim 2, Craig teaches the processing unit of claim 1, wherein the processing unit is further operable to power itself down where a portable storage device having the supplied network identity is not returned to the device reader within a predetermined time following removal of the portable storage device from the device reader (column 8, lines 3-9).

As per claim 3, Craig teaches the processing unit of claim 1, comprising first memory operable to store a default network identity for communication via the data communications network and second memory operable to receive the supplied network identity from the portable storage device (column 3, lines 61-62; column 5, lines 61-67; column 6, lines 38-52), wherein, when the card is not present, the host computer does keep a default communication state that is different than with the card present.

As per claim 4, Craig teaches the processing unit of claim 3, wherein the processing unit is operable on being powered up to determine whether a said portable storage device is present and, where a said portable storage device is present, to copy the supplied network identity from the portable storage device to the second memory and to use the supplied network identity (column 6, lines 57-60).

As per claim 5, Craig teaches the processing unit of claim 3, wherein the processing unit is operable to detect removal of the portable storage device from the device reader and to start a timer running to define a predetermined time (column 8, lines 3-9).

As per claim 6, Craig teaches the processing unit of claim 5, wherein the processing unit is operable to power itself down where a portable storage device having the supplied network identity is not returned to the device reader within the predetermined time following removal of the portable storage device from the device reader (column 8, lines 3-9).

As per claim 11, Craig teaches the processing unit of claim 1, wherein said portable storage device is a data card and the device reader is a data card reader (column 4, lines 21-26).

As per claim 12, Craig teaches the processing unit of claim 1, wherein said portable storage device is a smart card and said device reader is a smart card reader (column 4, lines 21-26).

As per claim 14, Craig teaches the processing unit of claim 1, comprising a service processor, the service processor being programmed to control reading of the device reader (column 6, lines 38-40).

As per claim 16, Craig teaches a control program for controlling the selection of a network identity for a processing unit connectable to a data communications network, the

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processing unit having a device reader operable to read a supplied network identity from a portable storage device, the control program being operable to select the supplied network identity from the portable storage device for communication via the data communications network, the control program being operable to monitor a continued presence of the portable storage device and, in the event of the removal of the portable storage device from the device reader, to signal a fault state (column 4, lines 28-32; column 8, lines 3-9; column 5, lines 21-24).

As per claim 17, Craig teaches the control program of claim 16, wherein the control program is further operable to cause the processing unit to power down where a portable storage device having the supplied network identity is not returned to the device reader within a predetermined time following removal of the portable storage device from the device reader (column 8, lines 3-9).

As per claim 18, Craig teaches the control program of claim 17, wherein the processing unit includes first memory operable to store a default network identity for communication via the data communications network and second memory operable to receive the supplied network identity from the portable storage device (column 3, lines 61-62; column 5, lines 61-67; column 6, lines 38-52), wherein, when the card is not present, the host computer does keep a default communication state that is different than with the card present.

As per claim 19, Craig teaches the control program of claim 18, wherein the control program is operable in response to the processing unit being powered up to determine whether a said portable storage device is present and, where a said portable storage device is present, to copy the supplied network identity from the portable storage device to the second memory and to

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select the supplied network identity if the portable storage device is present (column 6, lines 57-60).

As per claim 20, Craig teaches the control program of claim 18, wherein the control program is operable to detect removal of the portable storage device from the device reader and to start a timer running to define a predetermined time (column 5, lines 3-9).

As per claim 21, Craig teaches the control program of claim 20, wherein the control program is operable to cause the processing unit to power down where a portable storage device having the supplied network identity is not returned to the device reader within the predetermined time following removal of the portable storage device from the device reader (column 8, 3-9).

As per claim 27, Craig teaches a microcontroller programmed comprising a control program as recited in claim 16 (column 4, lines 28-32; column 8, lines 3-9; column 5, lines 21-24, 51-67).

As per claim 28, Craig teaches a server computer comprising a device reader, a processor, memory and a microcontroller as recited in claim 27, the microcontroller being operable as a service processor and connected to monitor the device reader to detect the presence of a portable storage device and to read content from the portable storage device (column 4, lines 28-32; column 8, lines 3-9; column 5, lines 21-24, 51-67).

As per claim 29, Craig teaches a method of controlling the selection of a network identity for a processing unit connectable to a data communications network, the method comprising: a device reader reading a supplied network identity from a portable storage device; using the supplied network identity from the portable storage device for communication via the

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data communications network; monitoring the presence of the portable storage device; and in the event of the removal of the portable storage device from the device reader, signaling a fault state (column 4, lines 28-32; column 8, lines 3-9).

As per claim 30, Craig teaches the method of claim 29, further comprising powering down the processing unit where a portable storage device having network identity is not returned in the device reader within a predetermined time following removal of the portable storage device from the device reader (column 8, lines 3-9).

As per claim 31, Craig teaches the method of claim 30, wherein a first memory in the processing unit stores a default network identity for communication via the data communications network and a second memory in the data processing unit receives the supplied network identity from the portable storage device (column 3, lines 61-62; column 5, lines 61-67; column 6, lines 38-52), wherein, when the card is not present, the host computer does keep a default communication state that is different than with the card present.

As per claim 32, Craig teaches the method of claim 31, further comprising, in response to the processing unit being powered up, determining whether a said portable storage device is present, and: where a said portable storage device is present, copying the supplied network identity from the portable storage device to the second memory; and selecting the supplied network identity (column 6, lines 57-60).

As per claim 33, Craig teaches the method of claim 32, comprising, in response to detecting removal of the portable storage device from the device reader, starting a timer running to define a predetermined time (column 8, lines 3-9).

As per claim 34, Craig teaches the method of claim 33, comprising powering down the processing unit where a portable storage device having the supplied network identity is not returned in the device reader within the predetermined time following removal of the portable storage device from the device reader (column 8, lines 3-9).

Allowable Subject Matter

6. Claims 7-10, 13, 15, 35-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. McCarthy whose telephone number is (703)305-7599. The examiner can normally be reached on M-F, 8 - 4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (703)305-9713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csm

April 22, 2004


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